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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,645	06/07/2001	Mingqiu Sun	884.439US1	9088

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EXAMINER

TANG, KENNETH

ART UNIT	PAPER NUMBER
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2195

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,645

Applicant(s)

SUN ET AL.

Examiner

Kenneth Tang

Art Unit

2195

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/13/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the Response on 4/13/06. Applicant's arguments have been fully considered but were not found to be persuasive.
2. Claims 1-36 are presented for examination.

Response to Arguments

3. *Applicant attempts to disqualify the Northrup (US2003/0101211 A1) reference by claiming that the Application's filing date, June 7, 2001, predates the publication date of Northrup, i.e., May 29, 2003.*

In response, Northrup publication (US2003/0101211 A1) is not disqualified because the filing date of the publication existed before the filing date of the Application.

4. *Applicant argues that the 35 USC 101 rejection is tangible because of the claimed data processing system.*

In response, the claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and **tangible result**." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Art Unit: 2195

In claim 1, in the specific case where the workflow is not completed by a first workflow engine, the mere “assigning the workflow” does not produce a tangible result. Therefore, claim 1, is non-statutory and the 35 USC 101 rejection stands.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 are directed to method steps which can be practiced mentally and therefore are directed to non-statutory subject matter. Specifically, as claimed, it is uncertain what performs each of the claimed method steps because it is not tangible.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al. (hereinafter Campbell) (US 2001/0024497 A1) in view of Sasou et al. (hereinafter Sasou) (US 5,463,208), and further in view of Northrup (US2003/0101211 A1).**

7. As to claim 1, Campbell teaches a method to be performed by a data processing system comprising:

providing distributed queuing of workflows (workflow manager), whose execution is requested by one or more execution-requesting clients, among a plurality of workflow engines (*page 5, [0084], page 6, [0085]*);

8. Campbell teaches a first workflow engine for an execution-requesting client. Campbell is silent on sending explicit and delayed acknowledgements.

9. In the Applicant's specification, "workflow" is defined to have a starting task and a finishing task with the possibility of intermediate tasks. Applicant also defines the "explicit and delayed acknowledgements" to be notification when the final task is completed.

10. Sasou teaches processing tasks and workflows (first task through last task) wherein notification occurs when the last task is completed (*see Abstract, col. 7, lines 9-12, etc.*). it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Campbell with Sasou because it would reduce loading and costs (*col. 2, lines 4-10, etc.*).

11. Campbell and Sasou are silent on assigning workflow to a second workflow engine if the first workflow is not completed. However, Northrup teaches that after determining that a workflow is not complete, assigning it to another node (*see page 3, claim 30*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Northrup with Campbell and Sasou because it would increase administrative control of the communication system (*see Abstract*).

12. As to claim 2, Campbell teaches wherein providing is performed by a load manager (workflow manager) (*page 5, [0084], page 6, [0085]*).

13. As to claim 3, Campbell teaches wherein the load manager comprises a commercially available middleware product (*page 15, [0208]*).

14. As to claim 4, Sasou teaches notification (*see Abstract*) and Campbell teaches wherein the explicit and delayed acknowledgement can be performed by email [0093]. It is well known in the art that messaging from email, for example, can be certified. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of certified messaging because this provides a guarantee in the delivery.

15. As to claim 5, Campbell teaches that all communication types are workflow enabled and pass through the load manager (workflow manager) (*page 5, [0084]*).

16. As to claim 6, Campbell teaches wherein the load manager comprises a commercially available middleware product (*page 15, [0208]*).

17. As to claim 7, Campbell teaches wherein the certified messaging capability is performed by a certified message receiver forming part of the workflow (*page 1, [0004], page 5, [0084]*).

Art Unit: 2195

18. As to claim 8, Sasou teaches sending an explicit and delayed acknowledgement to the execution-requesting client if the workflow is completed by the second workflow engine (*see Abstract, col. 7, lines 9-12, etc.*).

19. As to claims 9-16, they are rejected for the same reasons as stated in the rejection of claims 1-8, respectively.

20. As to claim 17, it is rejected for the same reasons as stated in the rejection of claim 1. In addition, Campbell teaches the computer operating in a fault-tolerant manner and requesting a workflow execution on behalf of a client (*page 2, [0043] and [0044], page 4, [0061] and [0063]*).

21. As to claims 18-22, they are rejected for the same reasons as stated in the rejection of claims 2, 4, 7, 8, and 17, respectively.

22. As to claim 23, it is rejected for the same reasons as stated in the rejection of claims 1 and 2.

23. As to claims 24-27, they are rejected for the same reasons as stated in the rejection of claims 4, 7, 8, and 17, respectively.

Art Unit: 2195

24. As to claims 28-33, they are rejected for the same reasons as stated in the rejection of claims 2, 4, 7, 8, 17 and 23, respectively.

25. As to claims 34-36, they are rejected for the same reasons as stated in the rejection of claims 4, 7 and 8, respectively.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Tang whose telephone number is (571) 272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

Art Unit: 2195

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kt
6/28/06


MENG-AI AN
SUPERVISORY PATENT EXAMINER
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